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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,878	05/30/2001	Vance M. Stephens	10003568-1	8982

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

RAHIMI, IRAJ A

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/870,878

Applicant(s)

STEPHENS, VANCE M.

Examiner

(Iraj) Alan Rahimi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.


**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**TWYLER LAMB**  
**PRIMARY EXAMINER**

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specification on page 12 lines 25-28 makes reference to what is claimed but does not provide sufficient detail as how the position of the print medium is shifted along a media path. Disclosure suggests some sort of mechanical shifting of medium based on the skew angle, but the mechanics of it are not disclosed. One could envision several different mechanisms for achieving the task but it is the responsibility of applicant to disclose the specifics of his invention.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Mizubata et al. (US patent 6,888,650).

Regarding claim 1, Mizubata discloses a method for printing an image on a print medium, comprising:

positioning the print medium at a print zone (column 1, lines 17-23);

determining actual medium size and/or medium placement characteristics (column 4, lines 45-52);

using size and/or placement characteristics, shifting an image to be printed relative nominal size and/or medium placement characteristics (column 5, lines 16-25 and column 6, lines 4-10); and

printing the shifted image on the medium (column 5, lines 16-25 and column 6, lines 4-10).

Regarding claim 2, Mizubata discloses the method of claim 1 wherein the image extends from lateral edge to lateral edge of the medium (Fig. 5).

Regarding claim 3, Mizubata discloses the method of Claim 1 wherein said actual medium size and/or placement characteristics include an absolute location of a point on a leading edge of the medium (column 5, lines 26-40).

Regarding claim 4, Mizubata discloses the method of claim 1 wherein said actual medium size and/or placement characteristics include a skew characteristic a leading edge of the medium (column 5, lines 16-21).

Regarding claim 5, Mizubata discloses the method of Claim 1 wherein said actual medium size and/or placement characteristics include medium length characteristic (column 4, lines 45-46).

Regarding claim 6, Mizubata discloses the method of Claim 1 wherein said actual medium size and/or placement characteristics include a medium width characteristic (column 4, lines 45-46).

Regarding claim 7, Mizubata discloses the method of claim 1 wherein said shifting said image includes digitally shifting the image in a direction aligned with or transverse to a medium advance axis (column 7, lines 36-42).

Regarding claim 8, Mizubata discloses the method of claim 1 wherein said shifting said image includes digitally rotating the image (column 7, lines 36-42).

Regarding claim 10, Mizubata discloses the method of claim 1 wherein an area of the image smaller than an area medium, so that margins are provided on the medium after said printing (column 6, lines 4-10).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11- 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizubata (US patent 6,888,650) in view of Muramatsu et al. (US patent 5,461,459).

Regarding claim 11, Mizubata discloses a method for duplex printing an image on a print medium, comprising:

positioning a front side of the print medium at a print zone (column 1, lines 17-21);

determining actual size and/or placement characteristics of the medium (column 4, lines 45-52);

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printing a front side image on said front side (column 6, lines 4-10);

However Mizubata does not disclose passing the print medium through a duplexing path to flip the print medium and present the back side of the print medium at the print zone for printing a back side image;

measuring leading edge and absolute location characteristics of the flipped print medium (column 5, lines 26-40); calculate shift parameters to shift the back side image to align with the front side image placement and print a shifted back side image.

Muramatsu et al. discloses a digital copying apparatus capable of rotating original image and duplexing features (abstract and column 5, lines 25-30).

Mizubata and Muramatsu are combinable because they are from the same field of endeavor that is image rotation and reproduction.

At the time of the invention, it would have been obvious to a person ordinary skill in the art to use a duplexer to print on both side of paper and to repeat the same image correction procedure for the image to be printed on the back side of the paper.

The suggestion/motivation for doing so would have been to reproduce the original in the same exact layout.

Regarding claim 12, Mizubata discloses the method of claim 1 wherein the image extends from lateral edge to lateral edge of the medium (Fig. 5).

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Regarding claim 13, Mizubata discloses the method of Claim 1 wherein said actual medium size and/or placement characteristics include an absolute location of a point on a leading edge of the medium (column 5, lines 26-40).

Regarding claim 14, Mizubata discloses the method of claim 1 wherein said actual medium size and/or placement characteristics include a skew characteristic a leading edge of the medium (column 5, lines 16-21).

Regarding claim 15, Mizubata discloses the method of Claim 1 wherein said actual medium size and/or placement characteristics include medium length characteristic (column 4, lines 45-46).

Regarding claim 16, Mizubata discloses the method of Claim 1 wherein said actual medium size and/or placement characteristics include a medium width characteristic (column 4, lines 45-46).

Regarding claim 17, Mizubata discloses the method of claim 1 wherein said shifting said image includes digitally shifting the image in a direction aligned with or transverse to a medium advance axis (column 7, lines 36-42).

Regarding claim 18, Mizubata discloses the method of claim 1 wherein said shifting said image includes digitally rotating the image (column 7, lines 36-42).



Regarding claim 20, Mizubata discloses the method of claim 1 wherein an area of the image smaller than an area medium, and an area of the back side image is smaller than said area, so that margins are provided on the medium after said printing of said front side image and back side image (column 6, lines 4-10).

***Other Prior Art Cited***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stolin (US patent 6,785,428) discloses rotated transform of an image using block transfers.

Sawada (US patent 6,807,320) discloses a method of correcting a sift in main scan direction.


***Contact Information***


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraj) Alan Rahimi whose telephone number is 571-272-7411. The examiner can normally be reached on Mon.-Fri. 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Alan Rahimi  
August 18, 2005

  
**TWYLER LAMB**  
**PRIMARY EXAMINER**